



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/605,720

10/22/2003

Daniel Suisa

FP2062

2719

43149

7590

01/05/2007

DANIEL SUIZA

JL. WALET PERMAI 4/33

PANTAI INDAH KAPUK, JAKARTA, 14470

INDONESIA

EXAMINER

PAIK, STEVE S

ART UNIT

PAPER NUMBER

2876

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
--	-----------	---------------

3 MONTHS

01/05/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/605,720

Applicant(s)

SUISA, DANIEL

Examiner

Steven S. Paik

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 12-19 is/are rejected.
- 7) ☒ Claim(s) 10 and 11 is/are objected to.
- 8) ☒ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 4 and 11 are objected to because of the following informalities: both claims recite "cardholder's" in lines 3 and 2 respectively. The examiner respectfully suggests correcting it by - - cardholder's - -. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 4 recites the limitation "the issuer" in line 2. There is insufficient antecedent basis for this limitation in the claim.

4. Regarding claim 9, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-4 and 7-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Valliani et al. (US 6,234,389).

Re claims 1, 4, 16, and 18, Valliani et al. disclose a system and method for approving a card transaction using a card (credit card or other card 230) of a cardholder comprising:

a digital signature (350) generated by a signature generation section (signature capture unit 255) of a cardholder apparatus based on transaction data (account number) and a reference code (a signal or code received from a host after verifying digitized signatures) of the cardholder which changes for each transaction by the cardholder (Memory 225 within smartcard 230 can store substantially more data than can one or even three magnetic stripes. An appropriate smartcard 230 may store user account number, present maximum dollar limit of the account, user identification as well as preferably encrypted PIN data.); and

a verification section for receiving a request for approval message including the digital signature and verifying the received digital signature to thereby approve the transaction (The various pinpad keys 300 facilitate user input of data, including for example PIN identification data, to facilitate a secure transaction made with card 230. As noted, a card owner's PIN is not stored, encrypted or otherwise, in magnetic stripe(s) 220 but may be stored in memory 225. To confirm that card 230 has not been lost or stolen, at the time of a transaction the person using card 230 may be required to manually input the PIN data, e.g., using pinpad unit 240 keys 300. Software-memory within circuitry 240 encrypts user-input PIN data and, using device 10 as an interface terminal, causes such encrypted data to be sent by device 10 to a host system 75. Host system 75 typically will have available PIN data for the true owner of card 230 and can rapidly confirm whether the pinpad input PIN and the known valid PIN agree. This comparison outcome can be sent by host system 75 to device 10, whereupon an individual using device and module 210 to transact a sale rapidly learns whether the sale should proceed, e.g., there is PIN-agreement. If there is discrepancy between the known valid PIN and the pinpad manually input PIN, device 10 can so indicate audibly via transducer 100 and/or visually via display 60, and the

Art Unit: 2876

transaction will be aborted. Furthermore, Valliani et al. disclose that a digitized version of the signature can be coupled to the host system, whereat a known signature of the true card owner can be stored. A comparison between the stored signature and the just-written signature can be made by the host system. The host system then notifies the point of sale system whether the two signatures appear to be written by the same person.).

Re claim 2, Valliani et al. discloses the system and method as recited in rejected claim 1 stated above, wherein the transaction data includes a transaction amount (In a preferred embodiment, smartcard reader/writer unit 260 can both read and write to memory 225. Thus, if prior to the present transaction memory 225 stored \$1,000 as the present card balance and if the present transaction is a \$200 debit, unit 260 can so debit memory 225 such that the new present card balance is \$800.).

Re claim 3, Valliani et al. discloses the system and method as recited in rejected claim 2 stated above, wherein the transaction data further includes account information of the cardholder (col. 5, ll. 14-29).

Re claim 7, Valliani et al. discloses the system and method as recited in rejected claim 1 stated above, wherein the generation the signature is done through authenticating the cardholder (comparison of digital signatures).

Re claims 8 and 17, Valliani et al. discloses the system and method as recited in rejected claims 1 and 16 stated above, further comprising a request for approval message of the transaction including the generated digital signature (An especially useful device for facilitating point of sale transactions is the PenWare model 3000, available from PenWare of Sunnyvale, Calif. Among other modes of input, the model 3000 provides a pressure pad upon which the

Art Unit: 2876

user writes a signature at time of transaction. A digitized version of the signature can be coupled to the host system, whereat a known signature of the true card owner can be stored. A comparison between the stored signature and the just-written signature can be made by the host system. The host system then notifies the point of sale system whether the two signatures appear to be written by the same person.).

Re claim 12, Valliani et al. discloses the system and method as recited in rejected claim 1 stated above, wherein the card is a credit card (credit card 230).

Re claim 13, Valliani et al. discloses the system and method as recited in rejected claim 1 stated above, wherein the card is a debit card (smart card 230 with a prepaid amount).

Re claim 14, Valliani et al. discloses the system and method as recited in rejected claim 1 stated above, wherein the card is in the form of an electronic chip (smart card, see col. 7, line 61 – col. 8, line 6) exchanging information with the cardholder apparatus (10 in Figs. 1-7).

Re claim 15, Valliani et al. discloses the system and method as recited in rejected claim 1 stated above, wherein the verification section is part of a card issuer apparatus controlled by a card issuer (remote host 75).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 5, 6, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Valliani et al. (US 6,234,389) in view of Fernandes et al. (US 2006/0000900A1).

Re claims 5, 6, and 19, the teachings of Valliani et al. have been fully discussed with the exception of disclosing a combination code the transaction data including merchant identification information and POS terminal identification information.

Fernandes et al. disclose a system and method for using mobile personal trusted device. The reference discloses that data string can be appended to data exchanges involving transactions with server 60. This data string will include part of a unique message transaction code (combination code) such as a message digest, digital signature, or a device serial number. The Merchant can also have preferences that relate to other types of transaction level authorizations. The Merchant's preferences may also require personalized data such as a Merchant's name and POS system adapter serial numbers that are programmed and used for collaborative negotiations with the Buyer's preferences. Whether it is the merchant's preferences or the buyer's preference, the transaction data may include the merchant's name and POS terminal identification number (serial number) to improve security of the financial transactions.

Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to have incorporated the system and method for using mobile personal trusted device with a transaction data including a Merchant's name and POS system adapter serial numbers as taught by Fernandes et al. for the purpose of increasing security of credit card or other card transactions.

Allowable Subject Matter

9. Claims 10 and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: none of the cited prior art of the record discloses, teaches, or fairly suggests a system comprising, among other things, a signature generation section further comprising a combination code and a second digital signature produced by combining the digital signature and the reference code based on the combination code and a verification section for receiving the second digital signature and separating the received second digital signature to recover the digital signature and the reference code based on the corresponding combination code. Claim 11 depends from claim 10.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bailey (US 2004/0104268A1) discloses an apparatus and method for converting a standard handheld cellular telephone into a handheld POS credit card terminal.


Zenou (US6,991,159) discloses a POS terminal including a socket for receiving and supporting a mobile communication device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven S. Paik whose telephone number is 571-272-2404. The examiner can normally be reached on Monday - Friday 5:30a-2:00p (Maxi-Flex*).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2876

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Steven S. Paik
Primary Examiner
Art Unit 2876

ssp